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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,364	04/12/2001	Tadamasa Kitsukawa	080398.P159C	6493

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EXAMINER	
TRAN, HAI V	

ART UNIT	PAPER NUMBER
2623	

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/834,364	KITSUKAWA ET AL.	
	Examiner	Art Unit	
	Hai Tran	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 June 2006*.

2a)☐ This action is FINAL. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-61* is/are pending in the application.

4a) Of the above claim(s) *1-20,25-28,34,35,39,44,47,48,50,51 and 54-57* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-24, 29-33,36-38,40-43,45-46,49,52-53,58-61* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/26/2006 has been entered.

Response to Arguments

Double Patenting:

In respond t o Applicant's remark (page 8 of 10), "...Applicant believe they are not required to submit a terminal disclaimer until the claims are allowable and only if the allowable claims are unpatentable over Kitsukawa' s claims", the Examiner agrees with Applicant that there is no requirement to submit a terminal disclaimer until the claims are allowable and only if the allowable claims are unpatentable over Kitsukawa' s claims; however, the intention of timely filed terminal disclaimer is NOT enough to overcome the rejection based on a nonstatutory Double Patenting ground, see MPEP § 804.02 [R-3] Avoiding a Double Patenting Rejection. Moreover, the intention of timely filed is NOT the same as timely filed as indicated in MPEP §804 "A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b)."

As such, the Examiner has the duty to maintain the rejection based on a nonstatutory Double Patenting ground until a Terminal Disclaimer is timely filed, regardless the claims is allowable or not.

Applicant's arguments, with respect to the rejection(s) of claim(s) 21, 36, 45 and 52 under 35 USC §103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Kikinis (US 5929849).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

the claimed invention is directed to non-statutory subject matter.

Claims 36-38,40-43 define a machine - readable medium embodying functional descriptive material. However, the claim does not define a *computer-readable medium* or *memory* and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and

functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized").

The examiner suggests amending the claim to embody the program on "computer-readable medium" in order to make the claim statutory.

For example, Claim 36 claimed "A machine-readable medium having stored thereon data representing sequences of instructions, when executed by a machine, cause the machine to perform operations comprising..." should be changed to the following:

A computer-readable medium encoded **thereon data representing** ***sequences of computer executable instructions, that when executed by a computer, cause the computer to perform operations*** --.

Note: the above suggestion should apply to all dependent claims 37-38, and 40-43.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 21- 22, 29, 30, 32-33 36-37, 40-42, 45-46, 49, 52 and 58-61 are rejected under 35 U.S.C. 102(e) as anticipated by Kikinis (US 5929849) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kikinis (US 5929849) in view of Holman (US 5285278).

Claims 21, Kikinis discloses a method comprising:

Receiving adverting information for a plurality of items along with a broadcast of a program (Col. 7, lines 55-Col. 9, lines 25);

Displaying a single advertising mark for the plurality of items on a display along with a scene of the broadcasted program (reads on displaying el. 57 of Fig. 2A);

Displaying a list of the plurality of items upon selection of the single advertising mark by a viewer (see el. 71 of Fig. 2C);

Displaying the received advertising information on the display upon selection of at least one of the plurality of items from the list by the viewer (for example the user selects one of the items, i.e. body style, from windows 71. The system inherently provides a corresponding picture of the body style item selected; see Col. 8, lines 25-38); and

As to "Storing the displayed advertising information upon selection by the viewer", this limitation is further met by Kikinis because upon selection the item within the windows 71 of Fig. 2C, corresponding Web page is downloaded; Thus, the downloaded pages are temporally stored/buffered in the memory. See Col. 9, lines 61-Col. 10, lines 5).

However, if Applicant disagrees with the Examiner assertion, then Holman (Col. 5, lines 18-22) discloses storing the displayed advertising information upon selection of a viewer for the benefit of later retrieving the selected information. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kikinis for storing the selected information, as taught by Holman, so the user able to later retrieve it.

Claim 22 and 46, Kikinis further discloses "further comprising storing advertising information for the or each selected item for a specified period of time after the broadcasted ends" reads on Kikinis downloaded Web pages that are temporally stored in the buffer/memory are removed from the buffer/memory once the broadcast program ends and replaced with new advertising information associated with new broadcast program.

However, if Applicant disagrees with the Examiner assertion, then Holman (col. 12. lines 21-29) teaches the claimed limitation for the obvious reason due to the limited storage of the storage media.

Claims 29 and 41, Kikinis (Fig. 2A, el. 57) further discloses wherein the displayed single advertising mark is superimposed over a broadcast of a program on the display.

Claims 30 and 42, Kikinis further discloses wherein the plurality of item are in the displayed scene (Fig. 2C, el. 71) and wherein the displayed single advertising mark (Fig. 2A, el. 57) comprises an indicator of the plurality of items in the displayed scene.

Claims 32 and 49, Kikinis further discloses wherein displaying the advertising information comprises displaying the advertising information on a portion of the display along with the broadcast of a program (Fig. 2C, el. 71; see Col. 8, lines 25-38).

Claim 33, Kikinis (Col. 8, lines 34-37) further discloses receiving a request from the viewer for electronically ordering the item using the advertising information.

Claim 36 is analyzed with respect to method claim 21 in which Kikinis clearly discloses various computer-readable medium having encoded thereon computer instructions (Col. 5, lines 25-55 and Col. 6, lines 1-13) to perform the method as claimed in claim 21.

Claim 37 is analyzed with respect to method claim 22 in which Kikinis clearly discloses computer instructions (Col. 5, lines 25-55 and Col. 6, lines 1-13) when executed by a computer to perform the method as claimed in claim 22.

Claim 40, Kikinis further discloses wherein the displayed advertising mark (reads on displaying el. 57 of Fig. 2A) comprises an indicator (emblem/hotspot) for a plurality of items for which advertising information is available, and wherein the indicator (emblem/hotspot) is representative of the item to which the indicator corresponds.

Claim 45, as analyzed with respect to method claim 21, Kikinis discloses an apparatus Fig. 1 comprising:

Means 13 for receiving adverting information for a plurality of items along with a broadcast of a program (Col. 7, lines 55-Col. 9, lines 25);

Means 51 for displaying a single advertising mark for the plurality of items on a display along with a scene of the broadcasted program (reads on displaying el. 57 of Fig. 2A);

Means 51 for displaying a list of the plurality of items upon selection of the single advertising mark by a viewer (see el. 71 of Fig. 2C);

Means 51 for displaying the received advertising information on the display upon selection of at least one of the plurality of items from the list by the viewer (for example the user selects one of the items, i.e. body style, from windows 71. The system inherently provides a corresponding picture of the body style item selected; see Col. 8, lines 25-38); and

As to "means for Storing the displayed advertising information upon selection by the viewer", this limitation is further met by Kikinis because upon selection the item within the windows 71 of Fig. 2C, corresponding Web page is downloaded; Thus, the downloaded pages are temporally stored/buffered in the memory 43/45/47/49. See Col. 9, lines 61-Col. 10, lines 5).

However, if Applicant disagrees with the Examiner assertion, then Holman (Col. 5, lines 18-22) discloses means for storing (internal memory of unit 1; see Fig. 3) the displayed advertising information upon selection of a viewer for the benefit of later retrieving the selected information. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kikinis for storing the selected information, as taught by Holman, so the user able to later retrieve it.

Claim 52, as analyzed with respect to method claim 21 in which Kikinis discloses an a receiver system Fig. 1 comprising a storage device 43/45/47/49, a processor 19 coupled to the storage device for performing the method as claimed.

Claims 58-61, Kikinis further discloses wherein the single advertisement mark is enable if the user has selected a stored advertisement mode (reads on activating the cursor 70), the advertising mark having been stored before being displayed in the stored advertisement mode, and wherein the single advertising

mark is disable if the user has selected a non-advertising mode (reads on do not activate the cursor 70) (see Col. 7, lines 38-Col. 8, lines 38).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claims 23-24, 31, 38, 43 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis (US 5929849) in view of Holman (US 5285278).

Claim 23, Kikinis does not disclose, "storing the displayed advertising information on a smart card."

Holman discloses storing the displayed advertising information on a smart card (Col. 12, lines21-29) upon selection of a viewer (Col. 5, lines 18-22).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kikinis to have selected advertisement to store on a smart card, as taught by Holman so to take the advantage of the portability of storage media.

Claims 24, 38 and 53, Holman further disclose storing information on the smart card regarding an associated broadcast of a program in association with the displayed advertising information (Col. 9, lines 59-64).

Claims 31, and 43, Kikinis in view of Holman (Col. 5, lines 33-40) further comprising recalling the stored displayed advertising information and displaying it at a time that is different from a display time of a scene in which an advertised item appears.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is (571) 272-7305. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HT: ht
09/14/2006

HAI TRAN
PRIMARY EXAMINER